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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,635	11/02/2001	Joseph C. Salamone	P02866	8360

23702 7590 05/04/2005

Bausch & Lomb Incorporated  
One Bausch & Lomb Place  
Rochester, NY 14604-2701

EXAMINER
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PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/003,635

**Applicant(s)**

SALAMONE ET AL.

**Examiner**

Kuo-Liang Peng

**Art Unit**

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 1/27/05 RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-13 and 19-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 27, 2005 has been entered. Claims 7-10 are amended. Now, Claims 7-13 and 19-28 are pending.

2. It is noted that the identifier of Claim 15 should read "(Withdrawn)".

3. Claim rejection(s) under 35 USC 102 in paragraph 6 of the previous Office Action (Paper No. 1004) is/are moot.

4. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 1004).

### ***Specification***

5. The disclosure is objected to because of the following informalities:

Art Unit: 1712

The CHART 1 in page 18 is improper. Applicants are advised to replace it with a formal drawing with a corresponding Brief Description of Drawing.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102 and 103***

6. Rejection of Claims 7-13 and 19-28 under 35 USC 102(b) as being anticipated by Kunzler (US 5 710 302) is maintained because the rejection is adequately set forth in paragraph 4 of Paper No. 1004. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

Applicants argue that Kunzler's monomer (Formula VI) contains an activated unsaturated group connected to the central Si atom by an alkylene group having 1-10 carbon atoms. However, this is not persuasive because Kunzler's monomer can be viewed as a monomer containing an activated unsaturated group connected to the central Si atom by an alkyleneoxy group, i.e.,  $-\text{O}-(\text{CH}_2)_{1-10}-$  and the activated unsaturated group can be a  $\text{CH}_2=\text{C}(\text{H}/\text{CH}_3)\text{C}(=\text{O})-$  group.

7. Rejection of Claims 7-11, 13, 19-28 under 35 USC 102(b) as being anticipated by and rejection of Claim 12 under 35 USC 103(a) as being

Art Unit: 1712

unpatentable over Meijs (US 5 981 615) are maintained because the rejections are adequately set forth in paragraph 5 of Paper No. 1004. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

Applicants argue that Meijs discloses a free-radical polymerizable group linked to a siloxane group by at least one linking group having at least one of -COO- and -CONH-. However, it is not persuasive because as mentioned in the previous Office actions, Meijs' macromer can be a macromer of formula (IVA) (col. 6, lines 24-39). Note that PDMS in formula (IVA) can be a residue of bishydroxyalkyl terminated poly(dimethylsiloxane) (col. 6, line 61 to col. 7, line 12 and Example 2). As such, Meijs formula (IVA) reads on Applicants' siloxysilane monomer recited in Claim 7 wherein two of y's are 0 and one of the y's is 1, the polymerizable group is  $\text{CH}_2=\text{C}(\text{CH}_3)\text{COOC}_2\text{H}_4\text{NHCO-}$  and the linking group is oxyalkylene group derived from the aforementioned bishydroxyalkyl terminated poly(dimethylsiloxane).

8. Claims 7-13 and 19-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Novicky (US 4 743 106).

Art Unit: 1712

Novicky discloses a polymeric composition produced through the polymerization of a monomer mixture comprising at least one of the (meth)acryloxy containing polyorganosiloxane monomers represented by the formulae described in col. 2, line 1 to col. 3, line 64. Note that in these formulae, X, Y and A can be independently C2-C6 alkyls or phenyl groups. (col. 2, line 1 to col. 3, line 64) Aromatic or non-aromatic non-siloxy-based monomers described in col. 5, line 62 to col. 6, line 20 and col. 6, lines 21-32 can be used. Hydrophobic monomers such as perfluoroalkyl containing monomers described in col. 4, line 28 to col. 5, line 39 and col. 6, lines 21-32 can be used. Hydrophilic monomers described in col. 5, line 62 to col. 6, line 20 and col. 6, lines 33-41 and 51-65 can be used. Methyl methacrylate, phenoxyethyl methacrylate, etc. can be used. (col. 6, lines 21-32) A strengthening agent such as cyclohexyl (meth)acrylate, etc. can be used. (col. 6, lines 21-32). A crosslinking agent such as ethylene glycol dimethacrylate, etc. can be used. (col. 6, lines 42-50)

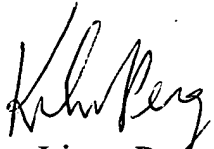
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

Art Unit: 1712

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
April 29, 2005

  
Kuo-Liang Peng  
Primary Examiner  
Art Unit 1712